Remarks/Arguments

Favorable reconsideration of this application is respectfully requested.

Claims 1-15 are pending in this application. Claims 8-15 have been withdrawn from consideration. Claims 1-7 are amended to better define the present invention without the introduction of any new matter.

The outstanding Office Action includes objections to the drawings and specification, rejections of Claims 1-7 under the first and second paragraphs of 35 U.S.C. § 112, a rejection of Claims 1-6 under 35 U.S.C. § 103(a) as unpatentable over Chen (U.S. Patent No. 5,936,419) in view of Matsudo (U.S. Patent No. 6,057,694) and an implied rejection of Claim 7[1] under 35 U.S.C. § 103 over Chen in view of Matsudo.

Initially, Applicants acknowledge with gratitude the interview granted by Examiners Patel and Cuneo to Applicants' representative on June 20, 2003. During the course of the discussion, Applicants' representative pointed out proposed drawing corrections to overcome the outstanding objections as well as proposed specification amendments to also overcome the outstanding objections. These proposals have been incorporated in the present amendment and are believed to clearly overcome these outstanding objections. If the Examiners believe that further changes to either the specification or drawings are required they are invited to contact Applicants' representative at the below-indicated telephone number so that mutually agreeable changes can be agreed upon.

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[1] The rejection statement on page 5 of the outstanding Action only lists Claims 1-6 as subject to this rejection while page 6 discusses Claim 7 as if it were included in this express listing of claims being rejected.

Turning to the outstanding rejections under the first and second paragraphs of 35 U.S.C. § 112, the Examiners expressed the view that the recitation in independent Claim 1 of the step of "bringing about a fritting phenomenon" implied that there were fritting probes used when this terminology was read in light of the specification. Applicants' representative pointed out that this reading of specification disclosure into much broader claim language was prohibited under prevailing precedent. See In re Priest, 199 USPQ 11, 15 (CCPA 1978) holding that infrarential limitations cannot to be read into the claims by the PTO.

In any event, in order to speed prosecution, Applicants have amended Claim 1 to make it absolutely clear that there is no basis for the assertions in the outstanding Action and at the June 20 meeting as to any third probe being used as the inspection probe, the incorrect interpretation of Claim 1 subject matter at the heart of the rejections under the first and second paragraphs of 35 U.S.C. § 112.

Furthermore, the Examiners should consider original Claim 2, the use of one probe 51 in Figure 6, the discussion of at least one probe for fritting on June 20, and the well-established fact that the breadth of claim language is not to be confused with indefiniteness or lack of adequate disclosure.

With regard to the difference between breadth of claim language and indefiniteness see In re Miller, 169 USPQ 597 (CCPA 1971). With regard to enablement, it is noted to be well established that in predictable mechanical or electrical arts, such predictability permits broad enablement. See In re Cook, 169 USPQ 298, 301 (CCPA 1971) as well as the above-noted Priest decision.

Accordingly, it is believed that the amendment of Claim 1 to include using at least one probe to bring about the fritting phenomenon with the use of the same at least one probe in electrical contact with the inspection electrode should be sufficient to overcome these outstanding rejections.

Turning to the outstanding rejection of Claims 1-6 and the implied rejection of Claim 7 over Chen in view of Matsudo, it was noted at the June 20 discussion that Chen does not inherently disclose the breaking of an insulating film formed over an inspection electrode because of any high voltage applied. As further explained on June 20, 2003, the Abstract of Chen makes it perfectly clear that any high voltage applied does not necessarily remove the insulating film over the electrode because it states that "if the insulation resistance is too high, then it is determined that the test sample is not properly connected and the test is terminated." The fact that the test is to be terminated because of the existence of too high an insulation resistance makes it clear that the high voltage applied is not sufficient to ensure the fritting phenomenon taught only by Applicants, contrary to the apparent opposite conclusion in the outstanding Office Action.

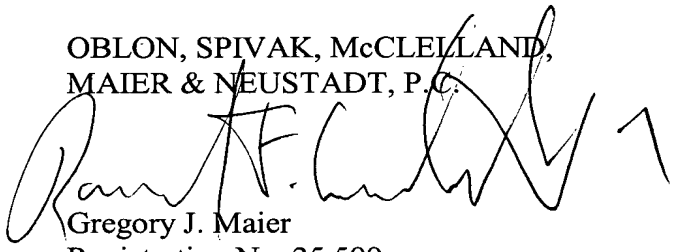
It is well established that before inherency can be relied on, it must be demonstrated that what is alleged to be inherent must always necessarily produce the asserted result. See In re Robertson, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999). Further note In re Oelrich, 212 USPQ 323, 326 (CCPA 1981) that makes it clear that inherency requires a certainty that something will happen, not a mere possibility or even a probability that something might occur.

Accordingly, Chen does not teach or suggest that a fritting phenomenon occurs with the application of high voltage, as the Abstract of this reference makes it clear that the application of high voltage does not always result in removal of the insulation film, and as it is further clear that Matsudo fails to contain any such teachings, the expressly stated rejection of Claims 1-6 and implied rejection of Claim 7 are traversed as lacking adequate evidentiary support.

As no further issues are believed to remain outstanding relative to this application, it is believed to be clear that this application is in condition for formal allowance and an early and favorable action to that effect is, therefore, respectfully requested.

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,
MAIER & NEUSTADT, P.C.



Gregory J. Maier
Registration No. 25,599
Attorney of Record
Raymond F. Cardillo, Jr.
Registration No. 40,440

22850

Tel.: (703) 413-3000
Fax: (703) 413-2220
GJM:RFC\la
I:\atty\rfc\213046us-am.wpd